

## **REMARKS**

At the time the current Official Action was mailed, the Examiner objected to claim 31 and rejected claims 1-34. By this response, claims 1, 2, 5, 7, 12, 18, 25, and 31 have been amended and new claims 35-45 have been added. Therefore, claims 1-45 are currently pending. No new matter has been added. Reconsideration of the application in view of these amendments and in view of the remarks set forth below is respectfully requested.

### **Claim Objections**

In the Office Action, the Examiner objected to claim 31. Applicant has amended claim 31 as suggested by the Examiner. In view of this amendment, Applicant respectfully requests that the Examiner withdraw the objection to claim 31.

### **Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1, 3, 12, 17-19, 22, 24, and 31 under U.S.C. § 102(e) as being anticipated by Chowanic et al. (U.S. Patent No. 6,505,118, hereafter “Chowanic”).

Applicant respectfully traverses this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the

rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicant may point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

The present application discloses an advantageous navigational system or method which may include one or more preferred routes in addition to any routes that may be calculated by the navigational system. Such a system may be particularly useful in situations where a user is very knowledgeable of conditions along a particular route, and thus may determine a better route than the navigational system would calculate. The system, by way of example, may learn one or more preferred routes based on vehicle position data as an operator drives from one place to another, or one or more preferred routes may be entered by a user or other knowledgeable source. These various routes may be presented to the user so that the user may select which route the user wishes the navigational system to utilize during the trip to the desired destination. As presently amended, independent claims 1, 12, 18, 31 generally recite, *inter alia*, a navigational system or method which calculates an optimal route, determines whether a preferred route is stored, provides the optimal route along with the preferred route to the user, and allows the user to select the preferred route or the optimal route.

In contrast, the Chowanic reference teaches a system that only learns and incorporates preferred routes. “If no preferred route segments are stored along the calculated route at 24, the system at 26 permits the user to navigate normally but does so in learning mode.” *See* Chowanic, column 3, lines 4-6. Once the system determines it is not traveling a preferred route segment, it goes directly into learning mode and provides little benefit to the operator. Thus, the Chowanic reference teaches a system that is limited to previously traveled routes. Furthermore, the Chowanic reference does not disclose presenting multiple routes to a user or allowing the user to select among multiple routes.

In view of the amendments and remarks set forth above, Applicant respectfully submits that the presently rejected claims contain subject matter that is not anticipated by the Chowanic reference. Therefore, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102 and allowance of the rejected claims.

#### **Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 2, 4-6, 13-14, 16, 20-21, and 32-33 under 35 U.S.C. § 103(a) as being unpatentable over Chowanic in view of Ohler (U.S. Patent No. 6,961,658, hereinafter “Ohler”); rejected claims 15 and 34 under 35 U.S.C. § 103(a) as being unpatentable over the Chowanic and Ohler references as applied to claims 12 and 31, and further in view of Stefan et al. (U.S. Patent No. 6,212,473, hereinafter “the Stefan reference”); rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over the Chowanic reference in view of Pu et al. (U.S. Patent 6,292,743, hereinafter “Pu”); and rejected claims 7-11 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over Pu in view of Ohler.

Applicant respectfully traverses these rejections. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As discussed above, the present application and claims are directed to, *inter alia*, a navigational system or method which calculates an optimal route, determines whether a preferred route is stored, provides the optimal route along with the preferred route to the user, and allows the user to select the preferred route or the optimal route. As discussed below, none of the references, taken either alone or in combination, disclose or suggest a navigational system or method having these features.

As recognized by the Examiner, the Pu reference does not disclose presenting the operator with a preferred route, as it only teaches downloading *one* calculated route from a server. *See* Pu, column 8, line 45-46. The system described in the Pu reference ignores the operator's preference and knowledge of regularly traveled routes. Although it teaches reading certain user preferences, it specifically limits them to items the user might want to avoid, like tollways, dirt roads, or major highways. *See* Pu, column 8, lines 26-29. Indeed, the "client profile" mentioned by the Examiner is only vaguely discussed at best in the Pu reference, and it certainly is not defined as even potentially including any route information related to the client or user.

The Ohler reference teaches a system that learns a preferred route and couples this with real time traffic information, but nothing in either the Pu reference or in the Ohler reference provides any suggestion whatsoever to support the Examiner's contention that it would have been obvious to include the preferred route information of Ohler in the client profile of Pu. Furthermore, the Ohler reference does not overcome the deficiencies of the Chowanic reference mentioned above. Specifically, the Ohler reference does not disclose calculating an optimal route, determining a preferred route, providing both routes to the user, *and* allowing the user to select among the routes, nor does it provide any suggestion to modify the Chowanic reference in this manner. On the contrary, the Ohler reference merely suggests that alternative routes may be considered by the Ohler system, but only the best route of those considered is presented to the vehicle operator for use on the trip.

Finally, the Stefan reference does not cure any of the deficiencies mentioned above. Indeed, the Examiner has only relied upon the Stefan reference for specific teachings related to dependent claims 15 and 34, so the Examiner has not even alleged that the Stefan reference addresses any of the issues discussed above.

In view of these deficiencies, Applicant respectfully submits that the cited references, taken alone or in combination, do not render obvious the subject matter set forth in the present claims. Therefore, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103 and allowance of all rejected claims.

#### **New Claims**

Applicant has added new claims 35-45. These new claims are dependent upon respective independent claims and generally recited that the preferred route of the system or method may be either entered by the user or learned using vehicle position data. Applicant respectfully submits that new claims 35-45 are allowable over the art of record for at least the same reasons as the respective independent claims discussed above.

Furthermore, Applicant authorizes the Commissioner to charge the appropriate fee for the additional claims to the attached PTO-2038. However, if the PTO-2038 is missing, if the amount listed thereon is insufficient, or if the amount is unable to be charged to the credit card for any other reason, the Commissioner is authorized to charge Deposit Account No. 06-1315; Order No. MOTA:0005/FLE (IS0118TC).

**Conclusion**

In view of the remarks set forth above, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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